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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,631	06/24/2003	Koji Naoc	Q76203	1135

23373 7590 03/20/2006  
SUGHRUE MION, PLLC  
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SUITE 800  
WASHINGTON, DC 20037

EXAMINER
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RICKMAN, HOLLY C

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CPL

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/601,631		NAOE	
	<b>Examiner</b>		<b>Art Unit</b>	
	Holly Rickman		1773	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/5/06 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2, 5, and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 contains the relative term "thin", which render the claims indefinite. The term "thin" is not defined by any of claims 1-2, 5 or 7, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is suggested that Applicant consider amending claim 1 to recite the limitations of claim 3 in order to clearly define the scope of the term "thin."

4. It is noted that the rejections of the claims under 35 USC 112, second paragraph as being rendered indefinite by the relative term "fast" have been overcome by Applicant's amendment of claim 1 to recite the specific circumferential speed encompassing the term "fast."

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsufuji et al (US 5064687) in view of Schunemann et al (US 6241376) and Asa (JP 2000-354751).

Matsufuji et al disclose a method for producing a magnetic recording medium having a non-magnetic substrate coated with a magnetic coating material containing a ferromagnetic powder and binder wherein the magnetic coating material contains a liquid A constituted by the ferromagnetic powder and a solvent, and a solution B of the binder. (See example 1).

Matsufuji et al teach the mixing together in an apparatus and subjecting to dispersion processing. The apparatus of Matsufuji et al may be broadly seen as a "thin" layer, "fast" stirring apparatus as in claims 1 and 3, but not disclosed as operable at the circumferential speeds of claims 1,5, or 7.

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However Schunemann et al describes an apparatus that may be described as a "fast" "thin" stirring apparatus. (See Col 1 lines 50-60.) and Asa describes another "fast" "thin" stirring apparatus capable of operation in a range meeting the limitations of claims 1, 5, and 7.

Therefore it would have been obvious to one of ordinary skill in the art to optimize the process and apparatus to maximize dispersion.

### ***Response to Arguments***

7. Applicant's arguments filed 1/5/06 have been fully considered but they are not persuasive.

Applicant argues that the specification defines the terms "thin" and the claims should be interpreted in light of the specification. However, the specification fails to provide an actual definition of the term "thin" and instead provides examples which do not serve to adequately define the metes and bounds of the term. Furthermore, it is noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, the examiner suggests that Applicant consider adding a limitation to claim 1 in order to more clearly define the scope of "thin."

With respect to the 103 rejection, Applicant maintains that the claimed use of a "thin-layer revolving fast stirring apparatus" is distinct from the kneading process taught by the prior art. It is the examiner's position that Applicant is reading limitations into the claim "thin-layer revolving fast stirring apparatus" that are not *defined* in the specification nor recited in the claims. If Applicant believes that a process using the "thin-layer revolving fast stirring

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apparatus” is different from that shown in the prior art, it is suggested that applicant amend the claims to more clearly distinguish the differences in the methods. For instance, by specifying that the “thin-layer revolving” apparatus requires the process step set forth in claim 3.

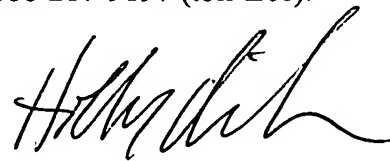
With respect to Applicant’s claim of unexpected results, the evidence set forth in the specification has been considered but is not commensurate in scope with the claimed invention. As noted previously, the examiner has reviewed the specification examples and comparative examples and finds basis for allowable subject matter. If the limitations of claims 2 and 3 were incorporated into claim 1, claim 1 would be allowable overcoming the 35 USC 112 and 103 rejections set forth in this Office action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Rickman whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Holly Rickman', with a stylized flourish at the end.

Holly Rickman  
Primary Examiner  
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